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**PATENT, TRADEMARK, COPYRIGHT
AND UNFAIR COMPETITION LAW
AND RELATED LITIGATION**

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TRUMAN A. HERRON 1935-1976
EDWARD B. EVANS 1936-1971

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Pages (including cover page): 5

Date: May 19, 2005

FROM: Keith R. Haupt, Esq.
Reg. No. 37,638

Re: This fax includes: Election with Traverse

Serial No.: 10/840,013
Filed: May 6, 2004
Examiner: Richard Thomas Price, Jr.
Group Art Unit: 3643
Applicant: William H. Thompson, III
and Stiles Thomas

Title: FEATHER ASSEMBLY FOR PREVENTING
BIRDS FROM FLYING INTO WINDOWS AND
ASSOCIATED METHOD OF USE
Conf. No.: 9636
Our Ref.: BBRI-02U

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Lisa L. Tucker Date

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Cincinnati, Ohio 45202

May 19, 2005

Mail Stop Amendment
Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

ELECTION WITH TRAVERSE

Sir:

This is responsive to the Restriction Requirement contained in the Office Action dated May 2, 2005. The Restriction Requirement asserts that claims 1-3 and 6-12 are drawn to a distinct invention from claims 14-18. Applicants hereby elect the Group I claims 1-3 and 6-12 for prosecution in this application. However, Applicants note that an

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amendment was filed on February 21, 2005 in this application in which new claims 20-22 were added. New claim 20 is directed to a feather assembly and depends from claim 7. Therefore, Applicants respectfully assert that claim 20 is properly included in the elected claims.

Applicants respectfully traverse the Restriction Requirement for the following reasons. The Office Action states that the inventions are related as process and apparatus for its practice and are distinct if it can be shown that "the process as claimed can be practiced by another materially different apparatus or by hand." (emphasis added) The Restriction Requirement asserts that "in this case, the process can be practiced by hand, in which, a person can waived (sic) his or her arms in front of the window in order to prevent birds from flying into the glass of the window." Applicants respectfully assert that the guidelines of the MPEP with respect to process and apparatus restriction requirements have not been followed.

As stated in the Office Action and in MPEP § 806.05(e), the proper analysis is directed to the process "as claimed." The alleged justification for the distinctive nature of the inventions is that the process claims can be practiced by hand. However, this fails to apply the claimed method which requires, among other things, "providing a feather assembly comprising the length of line and a plurality of brightly colored feathers secured to the line at spaced locations and securing one end of said length of line above said window and the other end of said line below said window." Applicants respectfully assert that this

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claimed method cannot be practiced in and of itself by hand as described in the Restriction Requirement.

The Examiner is respectfully reminded of MPEP § 806.01 which states that “in passing upon questions of double patenting and restriction, it is the claimed subject matter that is considered and such claimed subject matter must be compared in order to determine the question of distinctness or independence.” (emphasis added)

Moreover, Applicants respectfully assert that the Restriction Requirement is untimely in that it does not address currently pending claims including those new claims which were added in an amendment responsive to the first Office Action. Moreover, MPEP § 811 cautions against a restriction requirement after a first action on the merits as in this case.

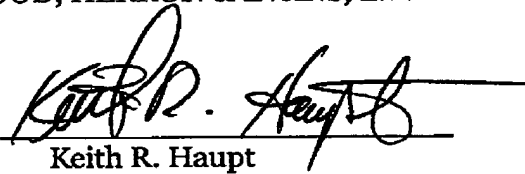
Further, the Restriction Requirement does not demonstrate that there will be a serious burden if the restriction is not required. Applicants respectfully assert that no burden is present because both the method and apparatus claims have already been examined in the first Office Action.

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As a result, Applicants respectfully traverse the Restriction Requirement and have provided comments and arguments herein that there is no material difference between the alleged group of claims.

Respectfully submitted,

WOOD, HERRON & EVANS, L.L.P.

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